

Applicant : Phillip M. Parker
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Attorney's Docket No.: 16485-005001

REMARKS

Applicant is in receipt of the office action mailed March 11, 2004. Claims 1, 16 and 29-31 are currently amended to more particularly point out and distinctly claim the present invention in order to advance this case toward issuance. No new matter has been added by these amendments and these amendments are fully supported by the specification. *See, e.g.*, Page 4, Lines 16-18; Page 7, Line 18 – Page 8, Line 17. Claims 1-31 are pending and under consideration, with claims 1, 16 and 29 being independent.

Applicant graciously thanks the Examiner for the interview granted to Applicant's representatives. The pending rejections in this matter were discussed, but no formal agreement was reached.

1. Claim Rejections under 35 USC §102

Claims 1-2, 5-10-14-19, 22-27 and 29-30, stand rejected under 35 USC §102, as being anticipated by US Patent 5,966,386 to Maegawa. Applicant respectfully traverses this rejection. Although Applicant does not agree that these claims are anticipated, in order to clarify the claimed invention and advance this case toward issuance, Applicant has amended claims 1, 16 and 29-30.

Amended independent claim 29 requires, in part, "automatically authoring, using a computer, an original book or literary work." Maegawa does not disclose or suggest "automatically authoring, using a computer, an original book or literary work." Instead, Maegawa is a "Multimedia Network System and Method of Communication of Same." Hence,

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Maegawa does not disclose "automatically authoring, using a computer, an original book or literary work."

The Office Action cites Figs. 18-20 of Maegawa in its rejection. However, these figures do not show "automatically authoring, using a computer, an original book or literary work." For example, the boxes "content authoring" [72] and "service authoring" [73] in Fig. 18 require input from a consumer – nothing is "automatically authored, using a computer."

With regard to amended claims 1 and 16, amended independent claim 1 requires, in part "automatically authoring, using a computer, an original title material" and amended independent claim 16 requires, in part, "an original title material, wherein said title material is automatically authored using said computer . . ." Title material includes, without limitation, books, literary works, and/or other publishable and/or authored work(s). *See, e.g.*, Page 7, Line 18 – Page 8, Line 17. Maegawa is a "Multimedia Network System and Method of Communication of Same" and does not disclose either "automatically authoring, using a computer, an original title material" or "an original title material, wherein said title material is automatically authored using said computer . . ."

The Office Action cites Figs. 18-20 of Maegawa in its rejection. However, these figures do not show "automatically authoring, using a computer, an original title material" or "an original title material, wherein said title material is automatically authored using said computer . . ." For example, the boxes "content authoring" [72] and "service authoring" [73] of Fig. 18 require input from a consumer – nothing is "automatically authored, using a computer."

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In addition, amended claims 1, 16 and 29 require an "original" title material (and/or book or literary work) to be automatically authored. Macgawa fails to disclose that an "original" title material (and/or book or literary work) is automatically authored.

Consequently, for at least the reasons above, Maegawa does not disclose each and every limitation of amended claims 1, 16 and 29. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn. Moreover, dependent claims 2, 5-10, 14-15, 17-19, 22-27 and 30 each depend directly or indirectly from one of the independent claims discussed above. Accordingly, these dependent claims are allowable for the reasons that their respective independent claims are allowable and for reciting allowable subject matter in their own right. Thus, even though Applicant has numerous arguments that the features of these dependent claims are also not disclosed in Maegawa, Applicant need not address those features specifically because Maegawa fails to disclose each and every limitation of the independent claims 1, 16 and 29. Independent consideration and allowance of these claims is requested. Therefore, Applicant respectfully requests that these claims be allowed.

2. Response to Claim Rejections under 35 USC §103

Dependent claims 3-4, 11-13, 20-21, 28 and 31 stand rejected under 35 USC §103. Specifically, claims 3, 20 and 31 stand rejected under 35 USC §103, as being unpatentable over Maegawa in view of US Patent 6,393,196 to Yamane *et al.* ("Yamane"). Claims 4 and 21 stand rejected under 35 USC §103, as being unpatentable over Maegawa in view of US Patent 6,628,303 to Foreman *et al.* ("Foreman"). Claims 11-13 stand rejected under 35 USC §103, as being unpatentable over Maegawa in view of US Patent 6,633,877 to Saigh *et al.* ("Saigh").

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Claim 28 stands rejected under 35 USC §103, as being unpatentable over Maegawa in view of US Patent 6,453,459 to Brodersen *et al.* ("Brodersen"). Applicant respectfully traverses these rejections. Although Applicant does not agree that these claims are rendered obvious, in order to clarify the claimed invention and advance this case toward issuance, Applicant has amended claims 1, 16 and 29-31.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the combined prior art references must teach or suggest all the claim limitations. See MPEP 706.02(j). As a *prima facie* case of obviousness has not been made, Applicant respectfully requests withdrawal of this rejection.

As demonstrated above, Maegawa fails to teach or suggest all the claim limitations of amended claims 1, 16 and 29. In addition, Yamane, Foreman, Saigh and Brodersen also fail to teach or suggest all the claim limitations of amended claims 1, 16 and 29. As the claims rejected under § 103 all depend from claims 1, 16 and 29, for at least this reason, Maegawa in combination with Yamane, Foreman, Saigh, or Brodersen fails to teach or suggest all the limitations of the claims.

Consequently, for at least the reasons stated above, the above references do not disclose each and every limitation of dependent claims 3-4, 11-13, 20-21, 28 and 31. Even though Applicant has numerous arguments that the features of these dependent claims are also not disclosed in Maegawa in combination with the above references, Applicant need not address

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those features specifically because the references fail to teach or suggest each and every limitation of the independent claims 1, 16 and 29. However, for example, regarding claims 3, 20 and 21, Yamane does not teach or suggest automatically authoring title material (and/or a book or literary work) in more than one language. The Office Action cites Col. 13, Lines 22-23 of Yamane. This cited passage references an existing work that has "data streams for audio in different languages." Yamane mentions nothing regarding "automatically authoring" an original title material (and/or a book or literary work) in more than one language.

Accordingly, for at least these reasons, the combination of Macgawa and Yamane, Foreman, Saigh, or Brodersen fails to teach or suggest all the limitations of claims 3-4, 11-13, 20-21, 28 and 31. Therefore, these claims are allowable for at least the reasons stated above. Thus, Applicant respectfully requests that these claims be allowed.

3. Conclusion

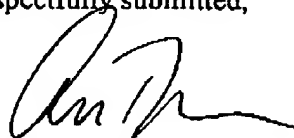
It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific issue or comment does not signify agreement with or concession of that issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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All of the pending claims are now in condition for allowance. A formal notice to that effect is respectfully solicited. Applicant respectfully requests that all claims be allowed. In the event any fees are due, the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 06-1050.

Respcctfully submitted,



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